



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,617	10/20/2003	Katsuhiko Akiyama	1405.1077	2603

21171 7590 09/08/2006

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

BOTTS, MICHAEL K

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,617

Applicant(s)

AKIYAMA, KATSUHIKO

Examiner

Michael K. Botts

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This document is a Final Office Action on the merits. This action is responsive to the following communications: Amendment, which was filed on June 14, 2006.
2. Drawing figures 2-5 were objected to. Applicant has appropriately amended drawings 2-5 and submitted replacement drawings. Accordingly, the objections to drawings 2-5 are withdrawn.
3. The Abstract of the Disclosure was objected to. Applicant has appropriately amended that abstract to shorten its length. Accordingly, the objection to the Abstract is withdrawn.
4. Claims 1-7 are currently pending in the case, with claims 1, 6, and 7 being the independent claims.
5. Claims 1-7 are rejected.

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-4, 6, and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassorla, et al., (U.S. Patent 5,146,552, issued September 8, 1992) [hereinafter

Art Unit: 2176

"Cassorla"], in view of Montlick, (U.S. Patent 5,561,446, issued October 1, 1996) [hereinafter "Montlick"].

Regarding **independent claim 1, as amended**, Cassorla in view of Montlick teaches:

A document browser that merges and displays additional information with document data, including text data and/or image data, that can be displayed on a display device, comprising:

additional information receiving means for receiving input of the additional information that includes handwritten pen-track data;

(See, Cassorla, col. 2, lines 23-25, teaching that than annotation ("additional information") may be stored within or separately from the published material.)

browsing means for merging and displaying on the display device the document data with the additional information that includes handwritten pen-track data;

(See, Cassorla, col. 2, lines 31-35, teaching the display of the additional information with the original document data.)

positional information obtaining means for obtaining the positional information of the additional information in the document data;

(See, Cassorla, col. 2, lines 41-44, teaching the use of relative position to fix the precise position of some annotations that the reader wants to pinpoint to a particular line or word position.)

*properties information obtaining means for obtaining properties
information of the additional information;*

(See, Cassorla, col. 4, lines 4-42, teaching a variety of properties that may be attached to annotations, including color, type style, etc.)

*additional information storage means for storing the additional information
that includes handwritten pen-track data with the positional information and the
properties information;*

(See, Cassorla, col. 5, lines 21-24, teaching storage of notes ("additional information") in a file or partition of a file on a host system or as a separate file on the local disk of a stand-alone workstation or personal computer.)

*additional information searching means for searching the additional
information stored in the additional information storage means based on the
properties information of the additional information; and*

(See, Cassorla, col. 9, lines 23-53, teaching search methods to recover additional information from memory storage locations and to associate that information with the appropriate text.)

*search results display means for displaying on the display device the
search results found by the additional information searching means.*

(See, Cassorla, col. 9, lines 23-53, teaching search methods to recover additional information from memory storage locations and to associate that information with the appropriate text.

Cassorla does not expressly teach handwritten pen-track data.

Montlick teaches "handwritten pen-track data" as "electronic ink." Specifically, Montlick teaches receiving, displaying, and storing electronic ink as additional information to text and graphics. See, Montlick, col. 2, line 37 through col. 12, line 4, specifically see, col. 9, lines 26-37, and col. 10, line 6 through col. 11, line 18, teaching associating electronic ink with annotations.

The teachings of Cassorla and Montlick are combinable in that that both involve the art of electronic annotation of text and graphics.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teaching of Cassorla and Montlick.

The suggestion or motivation to combine the references is that Cassorla teaches "notes" as textual annotations to a document. See, Cassorla, col. 4, line 55 through col. 5, line 30, teaching "notes" as annotations. Montlick teaches a handwritten, electronic ink, method of incorporating notes into an electronic document. Therefore Montlick merely adds another function, handwritten notes, to the typed notes taught by Cassorla. They are just different forms of entry for notes or annotations associated with a document.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Cassorla and Montlick to result in the invention specified in claim 1.)

Art Unit: 2176

Regarding **dependent claim 2**, Cassorla in view of Montlick teaches:

The document browser according to claim 1, wherein the document data is an HTML document, an XML document, or other structured document.

(See, Cassorla, col. 1, lines 12-66, teaching that the invention may be used with a structured document, including a markup language source document, and also including a document in the standardized general markup language (SGML).)

Regarding **dependent claim 3, as amended**, Cassorla in view of Montlick teaches:

The document browser according to claim 1, wherein the properties information includes: attribute information included in the additional information including line color, level of transparency, and line thickness; or other properties data of the additional information such as a shape classification, size, or date and time of input.

(See, Cassorla, col. 5, lines 18-21, teaching that once the reader has completed adding the additional information, the invention adds the topic, line number, author identification, date and time information to the text of the note.)

Regarding **dependent claim 4**, Cassorla in view of Montlick teaches:

The document browser according to any of the claims 1, wherein the additional information receiving means comprises a pen tablet, a mouse, or other pointing device.

Art Unit: 2176

(See, Cassorla, col. 3, line 12 through col. 4, line 3, teaching use of an appropriate action with a pointing mechanism such as a text or graphic cursor driven by a mouse, touch screen, joystick, keyboard or other command action, which is the same as the means claimed in the application.)

Regarding **independent claim 6, as amended**, Cassorla in view of Montlick teaches:

A document browsing method in which additional information is merged and displayed with document data, including text data and/or image data, that can be displayed on a display device, comprising:

displaying the document data on a display device;

receiving an input of additional information, including handwritten pen-track data, with respect to the document data displayed on the display device;

merging and displaying on the display device the document data with the additional information that includes handwritten pen-track data;

obtaining the positional information of the additional information in the document data;

obtaining properties information of the additional information;

storing the additional information that includes handwritten pen-track data with the positional information and the properties information;

searching the additional information stored in the additional information storage means based on the properties information of the additional information;
and

displaying on the display device the search results found by the additional information searching means.

(Claim 6 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding **independent claim 7, as amended**, Cassorla in view of Montlick teaches:

A computer readable medium encoded with processing instructions for causing a processor to execute a document browsing method, the document browsing method merging and displaying additional information with document data, including text data and/or image data, that can be displayed on a display device, and comprising:

displaying the document data on a display device;

receiving the additional information, including handwritten pen-track data, input to the document data displayed on the display device;

merging and displaying on the display device the document data with the additional information that includes handwritten pen-track data;

obtaining the positional information of the additional information in the document data;

obtaining properties information of the additional information;

storing the additional information that includes handwritten pen-track data with the positional information and the properties information;

searching the additional information stored in the additional information storage means based on the properties information of the additional information; and

displaying on the display device the search results found by the additional information searching means.

(Claim 7 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

7. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cassorla in view of Montlick as applied to claim 1 above, and further in view of Fitzpatrick, et al., "Translucent Window Attribute," IBM Technical Disclosure Bulletin, Vol. 36, No. 06A, pages 135-136, June 1, 1993 [hereinafter "Fitzpatrick"].

Regarding **dependent claim 5**, Cassorla in view of Montlick and further in view of Fitzpatrick teaches:

The document browser according to any of the claims 1, wherein the additional information is displayed semi-transparently so that the document data is identifiable when the additional information is merged with the document data.

(Cassorla in view of Montlick teaches the invention of claim 1, but does not expressly teach that the additional information is displayed semi-transparently so that the document data is identifiable when the additional information is merged with the document data.

Fitzpatrick expressly teaches a "translucent window," which is used when a container object is located on top of other container objects.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Cassorla and Montlick for the association of annotations with a document, with the teachings of Fitzpatrick that a window containing the annotation could be placed on top of the text, with the annotation displayed semi-transparently or translucently.

The suggestion or motivation to combine the references is expressed in Fitzpatrick which states that the translucent window attribute greatly expands the number of objects accessible by users for a given presentation space. Rather than forcing a note to occupy a column of a display screen, overlaying a note over a document in a translucent form prevents obstruction of the underlying document and thus greatly expands the number of objects accessible to the user for a given presentation space.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Cassorla and Montlick with the teachings of Fitzpatrick to result in the invention specified in claim 5.)

8. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon

for all that it would have reasonably suggested to one having ordinary skill in the art.
See, MPEP 2123.

Response to Arguments

9. Claims 1-5 were rejected under 35 U.S.C 112. Applicant correctly points out that only claim 3 contained the indefinite language of “such as.” Applicant has appropriately amended claim 3 to remove the term ‘such as” and obviate the rejection. Accordingly, the rejection of claims 1-5 are withdrawn.

10. Applicant's further arguments filed June 14, 2006 have been fully considered, but they are not persuasive.

Regarding rejections of claims 1-4, 6, and 7:

Applicant argues that Cassorla fails to teach or suggest the limitation of “handwritten pen-track data” as just amended into independent claims 1, 6, and 7. See, Amendment, pages 8-9.

The Examiner disagrees.

The rejections of claims 1, 6, and 7, above, combine Cassorla with Montlick in an obviousness type rejection. Montlick expressly teaches “electronic ink,” which is a commonly used term for “handwritten pen-track data.” Montlick teaches “handwritten pen-track data” as “electronic ink.” Specifically, Montlick teaches receiving, displaying, and storing electronic ink as additional information to text and

graphics. See, Montlick, col. 2, line 37 through col. 12, line 4, specifically see, col. 9, lines 26-37, and col. 10, line 6 through col. 11, line 18, teaching associating electronic ink with annotations.

The teachings of Cassorla and Montlick are combinable in that that both involve the art of electronic annotation of text and graphics.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teaching of Cassorla and Montlick.

The suggestion or motivation to combine the references is that Cassorla teaches "notes" as textual annotations to a document. See, Cassorla, col. 4, line 55 through col. 5, line 30, teaching "notes" as annotations. Montlick teaches a handwritten, electronic ink, method of incorporating notes into an electronic document. Therefore Montlick merely adds another function, handwritten notes, to the typed notes taught by Cassorla. They are just different forms of entry for notes or annotations associated with a document.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Cassorla and Montlick to result in the invention specified in independent claims 1, 6, and 7.

Regarding rejection of claim 5:

FIRST: Applicant argues that Fitzpatrick fails to cure the deficiencies of Cassorla with regards to claim 1, as amended. See, Amendment, pages 9-10.

The Examiner disagrees.

As stated above, the combination of the teachings of Cassorla and Montlick make obvious all of the limitations of claim 1, as amended.

Further, Cassorla and Montlick

SECOND: Applicant argues that there is a lack of motivation to combine the teachings of Fitzpatrick with Cassorla, arguing specifically that there is no motivation to combine a technology directed toward multiple windows in a GUI operating system (Fitzpatrick) with an invention that is directed only one window, a document (Cassorla). See, Amendment, page 10.

The Examiner disagrees.

In response to applicant's argument that there is no motivation to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in that Cassorla is not limited to "one window," as argued by Applicant. Rather, Cassorla teaches that the annotations may be reviewed and displayed separately from the associated document, which would have suggested to one of ordinary skill in the art at the time of the invention that the annotations may be displayed in a separate window from that of the original document. Therefore, one of ordinary skill in the art at the time of the invention would have been motivated to combine the teachings of Cassorla, with

Therefore, one of ordinary skill in the art at the time of the invention would have been motivated to combine the teachings of Cassorla, with separate windows for the document and its annotations, with the teachings of Montlick to display multiple windows using a "translucent window."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS for the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday through Friday 8:00-4:00

Art Unit: 2176

EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb

William S. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER